

## **REMARKS**

Favorable reconsideration is respectfully requested.

The claims, upon entry of the above amendment, will be 1 and 4 to 10.

The above amendment is responsive to points set forth in the Official Action.

Firstly, claim 1 has been amended by incorporating the features of claims 2 and 3, relative to the acid-dissociable group.

Further, claim 1 has been amended by including an amine compound as an essential component, i.e. component (C) of the claimed photoresist composition. Support is evident from page 10, line 3 from the bottom.

Claim 1 is further amended by reciting that the acid-generating agent is selected from the group consisting of diazomethane compounds and onium salt compounds of which the anionic counterpart is a C<sub>1</sub>-C<sub>15</sub> halogenoalkylsulfonate anion. Support is evident from page 9, lines 20 et seq. of the present specification.

The significance of the above amendments will become further apparent from the remarks below.

Claims 1 to 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatakeyama (U.S. 5,750,309).

This rejection is respectfully traversed.

The rejection appears to be based on the contention that all the essential components of the claimed photoresist composition are disclosed or suggested by the cited reference.

However, in view of the above amendments, such position is clearly untenable.

For example, the specific photoacid generator compounds claimed in claim 1 as component (B) are absolutely not disclosed nor suggested in Hatakeyama in view of the disclosure in the paragraph bridging columns 4 and 5 of the Hatakeyama reference.

In paragraph 7 of the Official Action, it is contended that the data in the declaration is not commensurate in scope with the claimed invention and that there is employed a preferred solvent, a preferred generator and preferred additives which are not set forth in the instant claims.

In reply, as recited in claim 1, an essential feature of the present invention resides in the proviso that the ratio of the maximum weight-average molecular weight  $Mw_{\max}$  to the minimum weight-average molecular weight  $Mw_{\min}$  of the first and second polyhydroxystyreneresins (A1) and (A2) be smaller than 1.5.

The Rule 132 Declaration of record, filed on November 20, 2003, clearly shows the importance of this feature since Experiment 1 has a ratio of 1.6, Experiment 2 has a ratio of 1.8 and Experiment 3 has a ratio of 1.3.

The first two experiments are outside the scope of the present claims whereas the third experiment is within the scope of the present claims.

As set forth in the conclusion of the declaration, the number of surface defects is considerably higher with the photoresist compositions outside the scope of the present claims.

The Examiner states that the composition comprises a preferred solvent, acid generator and preferred additives which are not claimed.

This comment is inapplicable to the present claims.

In connection with the preferred acid generator and additives, these are now set forth in the present claims, e.g. see components B and C.

The solvent is not an essential feature (see page 10, lines 21 and 22) and therefore, it is unnecessary to recite it in the present claims and as long as the solvent is the same in all comparative experiments of the Declaration, the comparison is valid..

Thus, the Declaration of record is based on experiments relevant to and commensurate in scope with the present claims.

With regard to the Examiner's suggestion to employ the composition of the prior art and vary the ratio of  $Mw_{\max}/Mw_{\min}$ , this would not appear to be necessary or appropriate especially with respect to the above amended claims, in view of the differences between the prior art and the present claims. For example, the present claims require specific photoacid generator compounds as component (B), which are not disclosed or suggested by Hatakeyama.


No further issues remaining, allowance of this application is respectfully requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact undersigned at the telephone number below.

Respectfully submitted,

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